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SJC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/033,662 03/03/98 HU

J 1488.1040001

HM22/0930

EXAMINER

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WASHINGTON DC 20005-3934

SAOUD, C

ART UNIT	PAPER NUMBER
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1646

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DATE MAILED:

09/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/033,662	Applicant(s) HU et al.
	Examiner Christine Saoud	Group Art Unit 1646

Responsive to communication(s) filed on Sep 2, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 2 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 26-65 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 26-65 is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

JOHN ULM
PRIMARY EXAMINER
GROUP 1800

J P

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. Claims 27, 29, 35, and 37 have been amended as requested in the amendment of paper #10, filed 02 September 1999. Claims 26-35 are pending in the instant application.

Specification

2. The amendment filed 03 March 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the recitation “which disclosure is herein incorporated by reference” is new matter for the reasons of record in paper #9.

Applicant is required to cancel the new matter in the reply to this Office action.

Applicant has chosen to argue that this amendment to the specification is not new matter. However, it is maintained that the amendment is new matter for the reasons of record. Applicant argues that “the declaration already refers to the material which applicants intend to incorporate by reference”. This statement is not correct because the declaration must include the section that states that the specification was amended (see the Declaration where it states “the specification of which [] is attached hereto or [x] was filed on 6/6/95 as Applicant Serial No. 08/469,641 and was amended on _____ (if applicable)”). This box should have been filled out. This is not in conflict with the Utility Patent Application Transmittal form which includes a box to be checked for

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Incorporation by Reference because the procedures for actually amending the specification to incorporate by reference are clearly set forth in the MPEP and require the amendment to be referred to in the oath or declaration. Applicant should note that this matter is a petitionable one at this point, and further argument to the Examiner will not advance the prosecution of the application.

Conclusion

3. This application is in condition for allowance except for the following formal matters:

The objection to the specification for new matter as described in the previous Office action and addressed above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Christine Saoud, Ph.D.
September 27, 1999

MS

9/28/99
JOHN WLM
PRIMARY EXAMINER
GROUP 1800